

REMARKS/ARGUMENTS

Reconsideration is respectfully requested of the Office Action of June 30, 2008, relating to the above-identified application.

Claim 23 has been corrected relating to an obvious error. Formula III in Claim 9 refers to a linear, noncyclic compound, whereas the compound of Claim 23 is a cyclic compound; namely, tetravinyl tetramethyl-cyclotetrasiloxane which is a species of Claim 7, formula II.

No new matter is present in amended Claim 23.

The rejection of Claims 22 under 35 U.S.C. § 102(b) in view of the *Mendez, et al.* article in Chem. Eur. J., vol. 8, No. 16, pp. 3620-3628 (2002) is traversed and reconsideration is respectfully requested.

The compounds shown in *Mendez, et al.*, in scheme 8 on page 2623 (formula XI, XII, XIII and XIV) solely represent a theoretical model to determine “the key intermediate(s) involved in the C-C forming step by coupling of the ally groups” as discussed in *Mendez* (pg. 3623, right col., second section, lines 22-26).

In particular, the complexes of formula XI, XII, XIII and XIV were never prepared or characterized, instead, they were used as the basis for computational “density functional theory (DFT) studies” leading to these complexes (pg. 3623, right col., end of second section). There is no synthesis procedure disclosed by *Mendez*.

Generally, the mere mention of a compound is only to be regarded as applicable prior art if there is an enabling disclosure to place the subject matter in possession of one skilled in the art.

This is not the case with *Mendez*. There is nothing in *Mendez* that teaches anything about the compounds, their characteristics and properties, how to make them or what they could be used for. Therefore, Claim 22 could not be anticipated by *Mendez*.

To constitute a proper anticipation, a printed publication must describe the invention. The description must be adequate for a person with ordinary skill in the art to which the invention pertains and must enable such a person not only to comprehend the invention, but also to make the invention. The listing of a chemical compound by name or formula as a speculative or theoretical possibility will not constitute an anticipation. Thus, an early case from the U.S. Supreme Court in 1870 indicated that a prior publication must contain a full enabling description in order to constitute anticipation. *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516 (1870).

In 1962, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) held in a case that a photograph of a hybrid rose in a publication would not constitute an adequate description of that rose such as would bar a plant patent. The photograph did not and could not enable one with skill in the art to make the rose. The Court stated:

Our study of the prior cases ... indicates that the proper test of a description in a publication ... requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in a printed publication and combine it with his own knowledge of the particular art and from this combination be put into possession of the invention on which a patent is sought.

In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962).

In 2000, the Federal Circuit spoke on this issue and said that “Invalidity by anticipation requires that the four corners of a single, prior art document described every element of the claimed invention, either expressly or inherently, such that a person with ordinary skill in the art could practice the invention without undue experimentation.” *Advanced Display Systems, Inc., v. Kent State University*, 212 F.3d 1272; 54 USPQ2d 1673, (Fed.Cir. 2000).

In 1964, the Court of Customs and Patent Appeals held in *In re Brown*, 329 F.2d 1006, 141 USPQ 242 (CCPA 1964):

To the extent that anyone may draw an inference from the *VonBramer* case that the mere printed contemplation which constitutes the designation of a “compound” is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 U.S.C. § 102 or 35 U.S.C. § 103 rejection...we totally disagree. ... Carrying such proposition to the extreme could, we think, result in a holding that a reference reciting a mere desirability of producing thousands of specifically named compounds without anything else is adequate to show that such compounds are old. We do not think that the *VonBramer* case was intended to be carried to such an extreme. We think, rather, that the true test of any prior art relied on to show or suggest that a chemical compound is old, is whether the prior art is such as to place the disclosed “compound” in the possession of the public. 329 F.2d at 1010-11.

In summary, it is clear that the cases, beginning all the way back in 1870 pointed out that for a reference to constitute an anticipation, the disclosure in that reference must be enabling.

Applicants respectfully submit that the disclosure in the *Mendez* is insufficient to enable a person skilled in the art to carry out the preparation of the disclosed compounds.

Reconsideration at the Examiner's earliest convenience is respectfully requested.

Respectfully submitted,

By: 
Robert G. Weilacher, Reg. No. 20,531

Date: September 29, 2008
SMITH, GAMBRELL & RUSSELL, LLP
Suite 3100, Promenade II
1230 Peachtree Street, N.E.
Atlanta, Georgia 30309-3592
Telephone: (404): 815-3593
Facsimile: (404): 685-6893